

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Docket Number (Optional)

P18159-US1

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Signature /Patricia Shultz/Typed or printed name Patricia ShultzApplication Number  
10/550,041Filed  
09/08/2006First Named Inventor  
Niklas JohanssonArt Unit  
3625Examiner  
Bayat, Bradley B.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.  
(Form PTO/SB/96)

☒ attorney or agent of record.  
Registration number 62,287
☐ attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 \_\_\_\_\_

/Brian M. Kearns, Reg No 62,287/

Signature

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Typed or printed name

972-583-9447

Telephone number

April 7, 2011

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.

☐ \*Total of 1 forms are submitted.

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicants:	Niklas Johansson , et al.	§	Group Art Unit:	3625
		§		
Application No:	10/550,041	§	Examiner:	Bayat, Bradley B
		§		
Filed:	09/08/2006	§	Confirmation No:	6177
		§		
Attorney Docket No:	P18159-US1			
Customer No.:	27045			

For: A Method And Apparatus For Supporting Content Purchases Over A Public  
Communication Network

Mail Stop Appeal Brief - Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

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Date: April 7, 2011

Name: Pamela C. Shultz

Signature: /Pamela C. Shultz/

Dear Examiner:

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Issues regarding the Pre-Appeal Brief Request are as follows:

**PENDING REJECTIONS**

Claims 1-17 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Publication No. 2004/0068473 to Cooper, et al. ("*Cooper*") in view of U.S. Patent Publication No. 2004/0029566 to Cunningham, et al. ("*Cunningham*"). Applicants continue to respectfully traverse these rejections. The proposed *Cooper-Cunningham* combination fails to disclose, teach, or suggest every element of the rejected claims.

## ARGUMENTS

**1.) The Examiner has not shown a *prima facie* case of obviousness for Claims 1-17.**

Applicant respectfully contends that the Examiner has not provided a "clear articulation of the reason(s) why the claimed invention would have been obvious," and therefore has not provided a *prima facie* case of obviousness for the rejected claims. M.P.E.P. ch. 2142.

**a. Independent Claims 1 and 10**

As previously argued, the Examiner has not shown a *prima facie* case of obviousness of all the rejected claims, including independent Claims 1 and 10. Specifically, the Examiner has not provided a suitable articulation of how the cited references disclose, teach, or suggest at least a method comprising "the content provider server sending a URL network address to the customer terminal to connect the customer with the transaction router for performing a purchase dialogue" as recited by claim 1.

To reject these claims, the Office Action originally cited to a portion of *Cunningham* that describes "a charging system" that, according to *Cunningham*, can be implemented using a conventional e-commerce system "with the addition of a single link to the toll sever on the content provider's sales confirmation web-page (e.g. a single button labeled 'Buy Now' or 'Proceed' etc)." *Cunningham* at ¶ 0126 (emphasis added). According to *Cunningham*, "[t]his link uses a URL which encodes the transaction data including amount, etc." *Id.* As *Cunningham* states, this link is added to a sales confirmation web-page and is used to encode the transaction data, i.e., it occurs after a transaction. Therefore, this URL is not used "to connect the customer with the transaction router for performing a purchase dialogue." Consequently, the cited portion of *Cunningham* fails to disclose the above-recited element from Claim 1. The Office Action conceded that *Cooper* failed to cure this omission.

In response, the Examiner has pointed to additional portions of *Cunningham*, stating that “[t]he toll server in *Cunningham* receives authorization data from a potential recipient and communicates data for validation and purchase wherein the toll server device enables links between the web server, the customer and the toll server.” Advisory Action at p. 2. However, the Advisory Action, along with the cited portions of *Cunningham* fail to clearly articulate how any such links connect a customer with a transaction router for performing a purchase dialogue. For at least these reasons, Applicant respectfully contends that the Examiner has not provided a *prima facie* case of obviousness, and Claims 1 and 10, along with their respective dependent claims, are allowable over the cited references. Applicant respectfully requests reconsideration and allowance.

**b. Dependent Claims 9 and 17**

In addition to the reasons articulated above, the Examiner has not shown a *prima facie* case of obviousness for dependent Claims 9 and 17. Specifically, the Examiner has not provided a suitable articulation of how the additional limitations of dependent Claims 9 and 17 are disclosed taught, or suggested by the cited references.

For instance, Claims 9 and 17 both recite the limitation wherein “each of said established relationships includes a business agreement and necessary technical interfaces.” These established relationships are established “with the content provider and with the access operator.” The Office Action relies on portions of *Cooper* as allegedly disclosing this limitation. Office Action at p. 5. However, the cited portions disclose a transaction validation server that may query a database to determine “what arrangements, if any, the customer 10 has made to pay for the content requested.” *Cooper* at ¶ 0017. As previously argued, this fails to disclose the cited limitation. Additionally, this cited passage merely discusses relationships between a requesting customer and a content provider. The claim limitations, on the other hand, relate established relationship between a content provider and access operator, those relationships including a

business agreement and necessary technical interfaces. The cited portion of *Cooper* fails to disclose any established relationship with an access operator, much less a business agreement and necessary technical interfaces.

In response to this clear rebuttal, the Examiner has not provided any response or additional articulation to support these obviousness rejections. See Advisory Action. For at least these reasons, Applicant respectfully contends that the Examiner has not provided a *prima facie* case of obviousness, and Claims 9 and 17 are allowable over the cited references. Applicant respectfully requests reconsideration and allowance.

**2.) The proposed *Cooper-Cunningham* combination is improper**

Applicant respectfully notes that, for an obviousness rejection to be appropriate, the Examiner must "identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does." *KSR Intern. Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1742 (2007). Applicant respectfully submits that the Examiner's proposed basis for combining the cited references has continuously failed to satisfy this requirement.

The Office Action dated July 23, 2010 contained only simple conclusory statements that failed to identify any reasoning or evidence that supports their conclusion. Additionally, as articulated by Applicant in the response, dated October 25, 2010, the Office Action mischaracterized the cited references. Under the proposed combination of *Cooper* and *Cunningham*, both the "validation request" of *Cooper* and the "link to the toll server" of *Cunningham* are used to transmit transaction data such as price to the same remote element. Thus, contrary to the assertions of the Office Action, the "link to the toll server" would not have "performed the same function as it did separately," because doing so would make the "link" completely redundant and superfluous in light of the "validation request 22" that carried the same information. Moreover, in light of this overlap in functionality, one of skill in the art would have no motivation to

combine *Cooper* and *Cunningham* as described, and the proposed *Cooper-Cunningham* combination is thus improper for at least these reasons.

In response, the Final Office Action, dated January 7, 2011, merely stated that "Applicant's argument of 'overlap in functionality' is unpersuasive and without merit because Applicant's conclusion of redundancy is erroneous." Office Action at p. 6. However, this is another conclusory statement, as the Office Action does not provide any articulated reasoning to clarify why Applicant's position is erroneous. The Advisory Action does not address the issue. As such, Applicant respectfully maintains that the proposed *Cooper-Cunningham* combination is improper, and the Examiner has not provided a suitable reason to justify their combination for use in an obviousness rejection.

### **CONCLUSION**

In view of the foregoing remarks, the Applicant believes all of the claims currently pending in the Application to be in a condition for allowance. The Applicant, therefore, respectfully requests that the Panel withdraw all rejections and issue a Notice of Allowance for all pending claims.

Respectfully submitted,

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